

ESTTA Tracking number: **ESTTA939020**

Filing date: **12/04/2018**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Regents of the University of Minnesota
Granted to Date of previous extension	02/06/2019
Address	600 McNamara Alumni Center 200 Oak St. SE Minneapolis, MN 55455 UNITED STATES
Attorney information	Stephen R. Baird / Tucker A. Chambers Winthrop & Weinstine, P.A. 225 South Sixth Street, Suite 3500 Minneapolis, MN 55402 UNITED STATES trademark@winthrop.com, sbaird@winthrop.com, tchambers@winthrop.com 612-604-6585

**Applicant Information**

Application No	87796865	Publication date	10/09/2018
Opposition Filing Date	12/04/2018	Opposition Period Ends	02/06/2019
Applicant	Ponderosa Advisors, LLC Suite 1400 518 17th Street Denver, CO 80202 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 042. First Use: 2018/02/21 First Use In Commerce: 2018/02/21 All goods and services in the class are opposed, namely: Software as a Service (SAAS) featuring data collection software with an integrated, interactive database, allowing users to access and analyze proprietary and public data in the fields of natural resources and project controls
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**Applicant Information**

Application No	87797249	Publication date	10/09/2018
Opposition Filing Date	12/04/2018	Opposition Period Ends	
Applicant	Ponderosa Advisors, LLC Suite 1400 518 17th Street		

	Denver, CO 80202 UNITED STATES
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## Goods/Services Affected by Opposition

Class 042. First Use: 2018/02/21 First Use In Commerce: 2018/02/21 All goods and services in the class are opposed, namely: Software as a Service (SAAS), featuring a data collection platform and interactive database to access and analyze proprietary and public data in the fields of natural resources and project controls
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## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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## Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	88176036	Application Date	10/31/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	B3		
Design Mark	<b>B3</b>		
Description of Mark	NONE		
Goods/Services	<p>Class 016. First use: First Use: 2003/04/14 First Use In Commerce: 2003/04/14 Printed publications containing building design guidelines for the construction or renovation of buildings for energy efficiency</p> <p>Class 042. First use: First Use: 2003/04/14 First Use In Commerce: 2003/04/14 Design and development of building design guidelines and benchmarking standards for energy efficiency for buildings; consulting in the field of energy efficiency for buildings; consulting in the field of building energy data science and analysis in the field of energy efficiency; providing a website and software as a service (SAAS) featuring software with an interactive database allowing users to analyze building energy data and benchmarking standards for energy efficiency for buildings</p>		

U.S. Application No.	88176038	Application Date	10/31/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	B3		

Design Mark	
Description of Mark	The mark consists of a stylized combination of the letter B and the number 3.
Goods/Services	<p>Class 016. First use: First Use: 2003/04/14 First Use In Commerce: 2003/04/14  Printed publications containing building design guidelines for the construction or renovation of buildings for energy efficiency</p> <p>Class 042. First use: First Use: 2003/04/14 First Use In Commerce: 2003/04/14  Design and development of building design guidelines and benchmarking standards for energy efficiency for buildings; consulting in the field of energy efficiency for buildings; consulting in the field of building energy data science and analysis in the field of energy efficiency; providing a website and software as a service (SAAS) featuring software with an interactive database allowing users to analyze building energy data and benchmarking standards for energy efficiency for buildings</p>

Attachments	88176036#TMSN.png( bytes ) 88176038#TMSN.png( bytes ) 20181203 Consolidated Notice of Opposition - B3 - Ponderosa Advisors with Exs A-D.pdf(2494036 bytes )
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Signature	/Tucker A. Chambers/
Name	Tucker A. Chambers
Date	12/04/2018

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial Nos.: 87/796,865 and 87/797,249  
Filed: February 14, 2018  
For the marks: B3 and B3 DATA. INSIGHT. OUTCOMES.  
Published in the *Trademark Official Gazette* on October 9, 2018

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Regents of the University of Minnesota,  
Opposer,

v.

Opposition No. \_\_\_\_\_

Ponderosa Advisors, LLC,  
Applicant.

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**CONSOLIDATED NOTICE OF OPPOSITION**

Regents of the University of Minnesota (“Opposer” or the “University”), a constitutional corporation organized and existing under the laws of the State of Minnesota, believes that it will be damaged by registration of the claimed B3 and B3 DATA. INSIGHT. OUTCOMES. marks shown in Application Serial Nos. 87/796,865 and 87/797,249, and hereby opposes the same on a consolidated basis pursuant to TBMP § 305.01. The grounds for opposition are as follows:

**Opposer’s B3 Marks**

1. Opposer was established in 1851 and, pursuant to the Constitution of the State of Minnesota, holds all of the rights, immunities, franchises, and endowments conferred upon the University by the Territorial Laws. Opposer received land grant status in 1862 and currently serves approximately 67,000 students across five campuses in the State of Minnesota.

2. Opposer has been ranked consistently as one of the country’s top research and innovation universities, is engaged in extensive research and product development programs, and is regularly ranked among the top universities both in the U.S. and the world.

3. Opposer is the owner of prior common law rights to the word mark B3 (“Opposer’s B3 Word Mark”) for goods and services in a variety of fields, including but not limited to, the fields of software, consulting, publications, and the development of guidelines for energy efficiency for buildings.

4. Opposer is the owner of prior common law rights to the stylized B3 mark shown below (“Opposer’s B3 Stylized Mark”) for goods and services in a variety of fields, including but not limited to, the fields of software, consulting, publications, and the development of guidelines for energy efficiency for buildings.



5. Opposer’s B3 Word Mark and Opposer’s B3 Stylized Mark (collectively, “Opposer’s B3 Marks”) are used in connection with services including, but not limited to, design and development of building design guidelines and benchmarking standards for energy efficiency for buildings; consulting in the field of energy efficiency for buildings; consulting in the field of building energy data science and analysis in the field of energy efficiency; and providing a website and software as a service (SAAS) featuring software with an interactive database allowing users to analyze building energy data and benchmarking standards for energy efficiency for buildings (“Opposer’s Services”).

6. Opposer’s B3 Marks also are used for printed publications, including, but not limited to, printed publications containing building design guidelines for the construction or renovation of buildings for energy efficiency (“Opposer’s Goods”).

7. Opposer, through its predecessor in interest and licensees, has continuously used Opposer's B3 Marks in commerce for Opposer's Services and Opposer's Goods (collectively, "Opposer's Goods & Services") since at least as early as April 14, 2003.

8. Opposer is the record owner of Application Serial No. 88/176,036 for the standard-character B3 mark in connection with Opposer's Goods & Services in Int'l Classes 16 and 42, claiming first use in commerce at least as early as April 14, 2003.

9. Opposer is the record owner of Application Serial No. 88/176,038 for the stylized B3 mark shown above, in connection with Opposer's Goods & Services in Int'l Classes 16 and 42, claiming first use in commerce at least as early as April 14, 2003.

#### **Applicant's B3 Applications**

10. Ponderosa Advisors, LLC ("Applicant") is the record owner of Application Serial Nos. 87/796,865 (the "'865 Application") and 87/797,249 (the "'249 Application") (collectively, "Applicant's Applications") for the standard-character mark B3 ("Applicant's B3 Word Mark") and the stylized mark B3 DATA. INSIGHT. OUTCOMES ("Applicant's B3 Stylized Mark") (collectively, "Applicant's Claimed B3 Marks").

11. Applicant filed Applicant's Applications on February 14, 2018, and has claimed first use in commerce at least as early as February 21, 2018.

12. Applicant's '865 Application identifies the services "Software as a Service (SAAS) featuring data collection software with an integrated, interactive database, allowing users to access and analyze proprietary and public data in the fields of natural resources and project controls" in Int'l Class 42, and Applicant's '249 Application identifies the services "Software as a Service (SAAS), featuring a data collection platform and interactive database to access and analyze proprietary and public data in the fields of natural resources and project controls" in Int'l Class 42 (collectively, "Applicant's Claimed Services").

13. Applicant's Claimed B3 Marks were published for opposition in the *Trademark Official Gazette* on October 9, 2018.

14. On October 23, 2018, Opposer filed a First 90-Day Request for Extension of Time to Oppose for both of Applicant's Applications. The Board granted these requests, extending the time to oppose until February 6, 2019.

15. This Notice of Opposition is timely filed.

**Count I: Priority and Likelihood of Confusion (Lanham Act § 2(d))**

16. Opposer restates and incorporates by reference the preceding paragraphs of this Notice of Opposition.

17. Opposer, through its predecessor in interest and licensees, has used Opposer's B3 Marks in commerce for Opposer's Goods & Services prior to the filing date of Applicant's Applications.

18. Opposer, through its predecessor in interest and licensees, has used Opposer's B3 Marks in commerce for Opposer's Goods & Services prior to Applicant's claimed first use date of February 21, 2018.

19. On information and belief, Opposer, through its predecessor in interest and licensees, has used Opposer's B3 Marks in commerce for Opposer's Goods & Services prior to any use by Applicant of Applicant's Claimed B3 Marks.

20. On information and belief, Opposer has priority over Applicant to use Opposer's B3 Marks for Opposer's Goods & Services.

21. Attached as Exhibit A is a true and correct copy of a webpage at <https://www.b3mn.org>, printed on December 3, 2018, which shows various examples of Opposer's uses of Opposer's B3 Marks.

22. Attached as Exhibit B is a true and correct copy of a webpage at <https://www.b3mn.org/guidelines>, printed on December 3, 2018, which shows various examples of Opposer's uses of Opposer's B3 Marks.

23. Attached as Exhibit C is a true and correct copy of a webpage at <https://mn.b3benchmarking.com>, printed on December 3, 2018, which shows examples of Opposer's uses of Opposer's B3 Marks for Opposer's Services by one of Opposer's licensees.

24. Attached as Exhibit D is a true and correct copy of a webpage at <https://mn.b3benchmarking.com/What-is-B3>, printed on December 3, 2018, which shows examples of Opposer's uses of Opposer's B3 Marks for Opposer's Services by one of Opposer's licensees.

25. Opposer has expended considerable time, effort, and money developing, promoting, advertising, and popularizing Opposer's B3 Marks in connection with Opposer's Goods & Services.

26. The purchasing public has come to know, rely upon, and recognize Opposer's B3 Marks as strong indicators of the source of Opposer's Goods & Services.

27. Opposer's B3 Marks are inherently distinctive.

28. Applicant's '865 Application for Applicant's B3 Word Mark claims a standard-character mark, without claim to any particular font style, size, or color of the mark.

29. Opposer's B3 Word Mark is identical to Applicant's B3 Word Mark.

30. Opposer's B3 Word Mark is visually identical to Applicant's B3 Word Mark.

31. Opposer's B3 Word Mark is identical in sound and pronunciation to Applicant's B3 Word Mark.



32. Opposer's B3 Word Mark has the same overall commercial impression as Applicant's B3 Word Mark.

33. Opposer's B3 Stylized Mark is similar to Applicant's B3 Stylized Mark.

34. The dominant element of Opposer's B3 Stylized Mark is the term "B3."

35. The dominant element of Applicant's B3 Stylized Mark is the term "B3" because it appears first and it is the largest element compared with the remaining text.

36. Opposer's B3 Stylized Mark is visually similar to Applicant's B3 Stylized Mark based on the appearance of the same dominant term "B3."

37. Opposer's B3 Stylized Mark is similar in style and design to Applicant's B3 Stylized Mark, based on the use of a negative space effect with the letter B and the number 3 in black-and-white, and based on the compressed combination of the letter B with the number 3.

38. Opposer's B3 Stylized Mark is similar in sound and pronunciation as Applicant's B3 Stylized Mark based on the appearance of the same dominant term "B3."

39. Opposer's B3 Stylized Mark and Applicant's B3 Stylized Mark are similar in their overall commercial impression.

40. Opposer's Services are related to Applicant's Claimed Services.

41. Opposer's Services are nearly identical to Applicant's Claimed Services with respect to the "Software as a Service (SAAS)" services.

42. Opposer's Services and the identification of Applicant's Claimed Services both include "Software as a Service (SAAS)" services.

43. Opposer's Services and the identification of Applicant's Claimed Services both include software as a service (SAAS) featuring software with an interactive database that allows analysis of public data.

44. The identifications of Applicant's Claimed Services set forth in the Applicant's Applications are unrestricted as to classes of consumers.

45. Therefore, Applicant's Claimed Services are presumed to be available to and directed to all classes of consumers.

46. The identifications of Applicant's Claimed Services set forth in the Applicant's Applications are unrestricted as to channels of trade.

47. Therefore, Applicant's Claimed Services are presumed to travel in all channels of trade.

48. Based on the similarity of Opposer's B3 Marks and Applicant's Claimed B3 Marks, and the relatedness of Opposer's Services and Applicant's Claimed Services, the registration of Applicant's Claimed B3 Marks for Applicant's Claimed Services would damage Opposer by causing a likelihood of confusion.

49. Opposer's B3 Marks so resemble Applicant's Claimed B3 Marks as to be likely, when used in connection with Applicant's Claimed Services, to cause confusion, to cause mistake, or to deceive as to affiliation, source, or sponsorship, to the detriment of Opposer.

50. For the foregoing reasons, registration of the marks shown in Applicant's Applications should be refused under Lanham Act §§ 2(d) and 13, 15 U.S.C. §§ 1052(d), 1063.

**WHEREFORE**, Opposer requests that the Trademark Trial and Appeal Board:

1. Sustain this Opposition;
2. Refuse registration of the marks shown in Application Serial Nos. 87/796,865 and 87/797,249; and
3. Grant Opposer any further relief the Board deems equitable.

Dated: December 3, 2018

WINTHROP & WEINSTINE, P.A.

*/Tucker A. Chambers/*

Stephen R. Baird

Tucker A. Chambers

225 South Sixth Street, Suite 3500

Minneapolis, Minnesota 55402

(612) 604-6400

*Attorneys for Opposer*

16520857v1

# **EXHIBIT A**

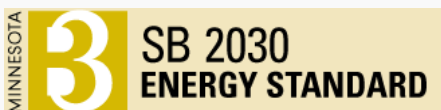


The B3 tools and programs are designed to help make buildings more energy efficient and sustainable. The B3 programs have been developed for and are required on State-funded projects in Minnesota, however they are easily applied to any project. The B3 Guidelines and the SB 2030 Energy Standard can be applied to new and renovated buildings during design. B3 Benchmarking, B3 Energy Efficient Operations and the B3 Post Occupancy Evaluation (POE) can be used to evaluate and improve existing buildings.

## Design of New Buildings and Renovations



Use [B3 Guidelines](#) on new buildings or renovations to meet sustainability goals for site, water, energy, indoor environment, materials and waste.



Use the [SB 2030 Energy Standard](#) to meet energy use goals only. If the B3 Guidelines are used, the SB 2030 Energy Standard is automatically included in the process.

## Operation of Existing Buildings



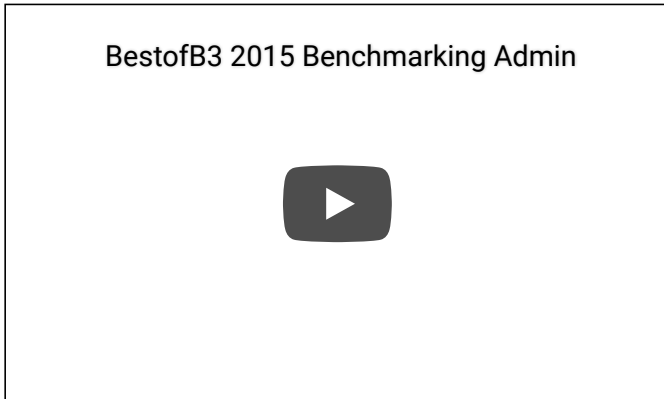
Use [B3 Benchmarking](#) to track and compare energy use on existing buildings. The B3 Guidelines and SB 2030 Energy Standard direct the user to the B3 Benchmarking tool.



Use [B3 Energy Efficient Operations](#) to minimize energy use during building operations. This program can be applied to any existing building.



Use [B3 Post Occupancy Evaluation \(POE\)](#) to determine occupants' perceptions of the buildings' indoor environmental quality. The POE survey is required for B3 buildings.



Check out the [B3 YouTube Channel](#) to learn how Minnesota organizations and project teams have successfully used the B3 programs to design and operate sustainable, energy-efficient buildings.

## CONTACT US

If you have any questions or suggestions for improvements, please contact us.

- B3 Program Overall: [info@b3mn.org](mailto:info@b3mn.org)
- B3 Guidelines: [guidelines@b3mn.org](mailto:guidelines@b3mn.org)
- SB 2030 Energy Standard: [sb2030@b3mn.org](mailto:sb2030@b3mn.org)
- B3 Benchmarking: [benchmarking@b3mn.org](mailto:benchmarking@b3mn.org)
- B3 Energy Efficient Operations: [operations@b3mn.org](mailto:operations@b3mn.org)
- B3 Post Occupancy Evaluation: [poe@b3mn.org](mailto:poe@b3mn.org)



- [B3 Guidelines](#)
- [B3 SB 2030 Energy Standard](#)
- [B3 Benchmarking](#)
- [B3 Energy Efficient Operations](#)
- [B3 Post Occupancy Evaluation](#)

- [Sponsors](#)
- [Project Team](#)
- [Case Studies Database](#)
- [Contact Us](#)

# **EXHIBIT B**



The B3 Guidelines can be applied to the design of new buildings or renovations to meet sustainability goals for site, water, energy, indoor environment, materials and waste. The B3 Guidelines are required on all projects that receive general obligation bond funding from the State of Minnesota. The guidelines can also be used on a voluntary basis on any project. By using the B3 Guidelines, projects will automatically be applying the [SB 2030 Energy Standard](#). After design, during the building occupancy period, the building will also use the [B3 Benchmarking](#) tool to track and compare actual energy use and the [B3 Post Occupancy Evaluation \(POE\)](#) to survey occupants on the indoor environmental quality of the building.

[B3 Version 3.1](#) has been released and is applicable for projects beginning predesign or enrolled in the B3 Guidelines Tracking Tool on or after January 1, 2019.



Performance Management



Site & Water



Energy & Atmosphere



Indoor Environmental Quality



Materials & Waste

Projects beginning Predesign and those signing up to the B3 Guidelines Tracking Tool on or after January 1, 2019 are required to use [Version 3.1](#) of the B3 Guidelines. Projects already active in the Tracking Tool under previous versions are permitted to continue with the applicable guideline. Older projects may elect to use Version 3.1, though the Tracking Tool will not carry forward previously input guideline information.

## To Begin the Process

As soon as you have identified that you have a project that has or is planned to receive State bond money, contact B3 Guidelines Support to get your project set up in the B3 Guidelines Tracking Tool. Contact Patrick Smith 612-626-9709 or [guidelines@b3mn.org](mailto:guidelines@b3mn.org) for assistance.

## B3 Guidelines Tracking Tool



## B3 Case Studies Database

The [B3 Case Studies Database](#) provides design and performance information on projects using the B3 Guidelines and the SB 2030 Energy Standard. Each project case study includes a Scorecard with several performance metrics including energy, carbon, water, stormwater, and waste. The case study also includes an SB 2030 Label indicating the projects Energy Use Intensity (EUI) during design and actual performance.



**B** Guidelines

**B** SB 2030 Energy Standard

**B** Benchmarking

**B** Energy Efficient Operations

**B** Post Occupancy Evaluation

**Sponsors**

**Project Team**

**Case Studies Database**

**Contact Us**

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# **EXHIBIT C**



## Advanced Metrics for Rating Buildings

[Learn More](#)

### What is B3?

Funded by the MN Departments of Commerce and Administration, B3 Benchmarking puts the power of public building energy data in the hands of Minnesota public building owners to manage and reduce energy costs.

[Learn more » \(What-Is-B3\)](#)

### Features & Benefits

Benchmark energy modeling, peer comparisons, ENERGY STAR® scores, target tracking, and dynamic reporting help you understand the performance of your buildings.

[Learn more » \(Features-And-Benefits\)](#)

### Testimonials

“We use B3 Benchmarking to pinpoint problem buildings and fix issues before they turn into large problems.”  
Teri Thompson, City of Lake Crystal


[More Testimonials » \(Testimonials\)](#)


# Benchmarking Automation

Learn how B3 Benchmarking can provide a secure method of automatically uploading consumption data from participating utilities into your B3 Benchmarking portfolio. [Learn More](#)

## Contact Us

 [Contact Forms \(Contact-Us\)](#)

 [support@b3benchmarking.com \(mailto:support@b3benchmarking.com\)](mailto:support@b3benchmarking.com)

 952-939-1878

## Partners



<http://www.b3mn.org>




<http://mn.gov/commerce>



<http://mn.gov/admin>

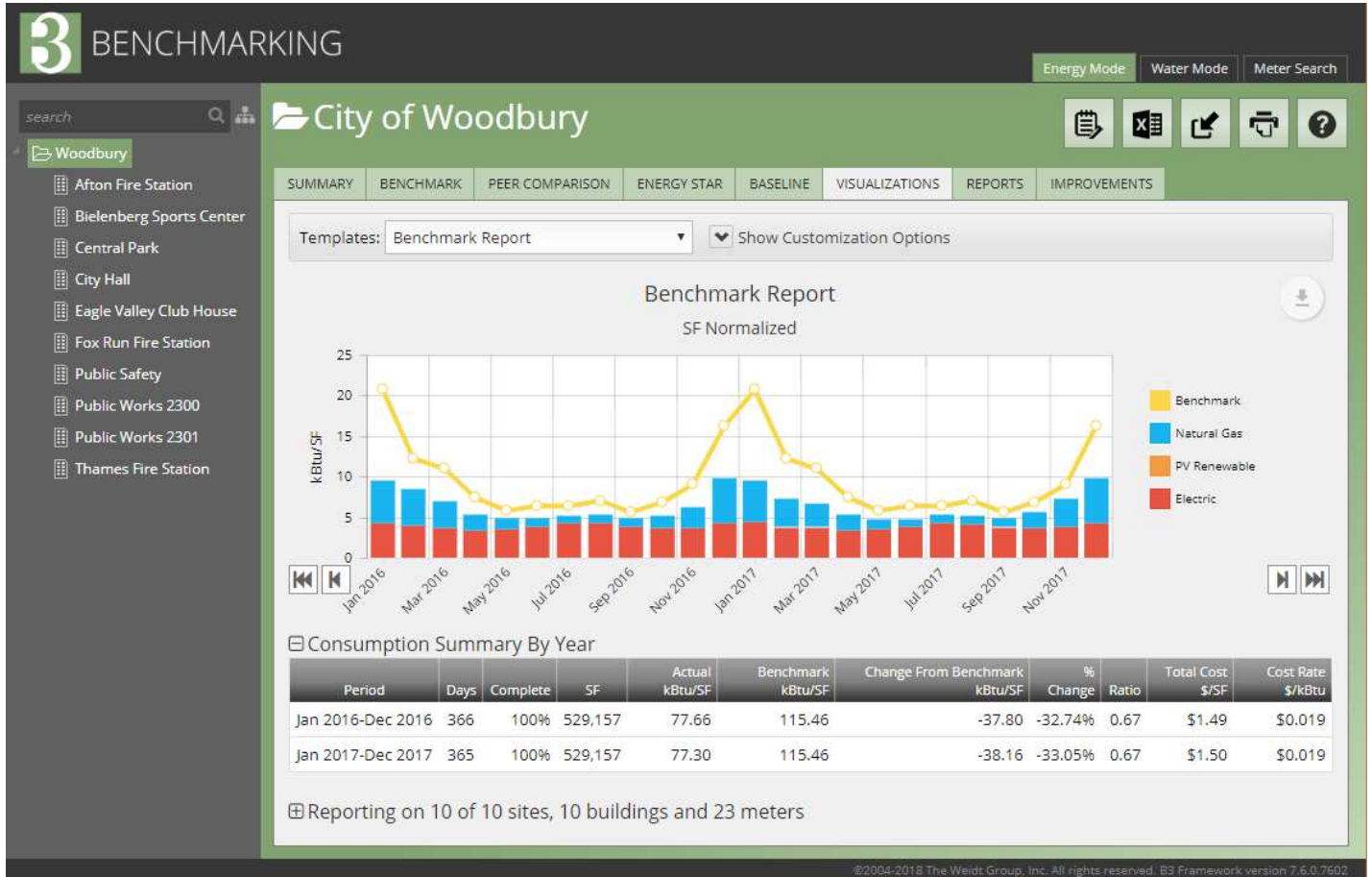


 <http://www.twgi.com>

# **EXHIBIT D**

# Building Energy Data in your Hands

B3, which stands for Buildings, Benchmarks, and Beyond, puts the power of building energy data in your hands. Using basic building and meter information, the online tool summarizes energy consumption, costs, and carbon emissions in easily digestible monthly and annual reports for Minnesota public buildings.



## Lower your costs

By reducing energy consumption, you lower your operating costs – freeing up money for your organization’s core services.

B3 Benchmarking helps you ensure your building is operating and performing as expected, and the tool screens buildings that would provide the greatest return on investment from any building improvements.

## The Power of Perspective

Have you ever been asked, "How do your buildings compare?" B3 uses complex analyses that allow you to compare a building from four major perspectives. This multiple-angle approach helps you identify weak buildings and gives you the confidence that an identified poor performer is truly in need of improvement and will yield significant returns on investment.

### Benchmark

An engineering modeling comparison using DOE-2 simulations and B3 energy standards predicts expected energy use.

### Peer Comparison

An evaluation of a building to others with similar space usage, geographic location, and energy code provides true peer comparison.

### ENERGY STAR®

A simple 0-100 score produced by ENERGY STAR® Portfolio Manager analyzes a building against similar buildings across the US.

### Baseline


A weather-normalized comparison of a building to itself over time provides monthly and annual analysis.


## Over a Decade of Benchmarking Expertise

In 2001, legislation (MN-session-law.aspx) in the State of Minnesota was passed to benchmark all public buildings in the state for a period of 12 months, and as a result, B3 Benchmarking was born. For more than 10 years, The Weidt Group® has developed the benchmarking application to be one of the most robust tools for tracking and managing energy use in public buildings. Currently, the B3 Benchmarking program contains over 7,500 public buildings with over 300 million square feet in its database representing 22 State agencies, 410 cities, 55 counties, 60 higher education campuses, and 214 school districts. The B3 Benchmarking system has identified over \$23 million in potential energy savings in over 1,500 identified buildings representing about 30 million square feet of building floor area. View more information in this Current Statistics Report (Statistics) .

### Contact Us

 [Contact Forms \(Contact-Us\)](#)

 [support@b3benchmarking.com \(mailto:support@b3benchmarking.com\)](mailto:support@b3benchmarking.com)

 952-939-1878

### Partners



<http://www.b3mn.org>



<http://mn.gov/commerce>



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